

## REMARKS

Claims 1 and 3-12 remain in this application. No amendments are being made in this paper. Claim 1 is the only independent claim now presented. No new matter has been added. Reconsideration and further examination are respectfully requested.

In regard to the pending provisional double patenting rejection, applicant believes the Examiner's reasoning is faulty, but, in order to more rapidly advance this case to allowance, applicant is filing a Terminal Disclaimer herewith to obviate this rejection.

### Claim Rejections – 35 USC § 103

Claims 1 and 3-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maltzman (2002/0107779) in view of Moshal et al. (2001/0042041), Sloan et al. (2005/0091140), Sheehan et al. (2001/0049647), Buist et al. (2002/0035534) and Ausubel et al. (2004/00554551), Agarwal et al. (2002/0099646), Hoffman et al. (2002/0049664) and Official Notice.

This rejection is respectfully traversed for reasons that are set forth below.

Claim 1 is directed to a “computer implemented method for allocating shares of stock comprising an initial public offering”. The method recited in claim 1 includes “offering in a computer system, a subset of the shares to one or more pre-auction bidders at a pre-auction price” and “receiving into a memory in the computer system, an indication from the one or more pre-auction bidders accepting the offer for the shares at the pre-auction price”. The method of claim 1 further includes “publishing in the computer system, information descriptive of one or more pre-auction sales of shares comprising the initial public offering”. In addition, claim 1 specifies that “said information descriptive of the pre-auction sales of shares includ[es] the pre-auction price and identification of bidders who bought shares at the pre-auction price”. Finally, claim 1 includes the method steps of “accepting into the memory in the computer system, the offer for shares at the pre-auction price” and “auctioning with a processor in the computer system, the remaining shares”.

It appears to applicant that in the latest Office Action the Examiner has attempted to plug some of the more glaring holes in the rejection as stated in the prior Office Action. Nevertheless, since the Examiner continues to rely on the same references, the same basic problem remains, which is that the Maltzman reference is an unsuitable primary reference, and bears little relationship to the subject matter of claim 1.

In sections 3 and 4 of the present Office Action, the Examiner tries to defend his continued reliance on Maltzman by citing the *Oetiker* case, and the standard stated therein that a reference, to be considered analogous art, “must either be in the field of applicant’s endeavor or, if not, then reasonably pertinent to the particular problem with which the applicant was concerned”. However, the Examiner goes on to misapply this standard, by misstating the respective subjects of this application and of Maltzman, and by blurring the difference between them.

The field of this applicant’s endeavor is initial public offerings of shares of stock; Maltzman is not in this field, being concerned with sales of goods via online auction websites. The particular problem with which the applicant was concerned was alleviating the potential for favoritism in the allocation and pricing of IPO shares; there is nothing in Maltzman’s teachings that is pertinent to this problem. Maltzman is merely concerned with pre-auction sales of goods at a fixed price via an auction website.

Hence, Maltzman fails the *Oetiker* test and is not qualified for use as prior art against this application.<sup>1</sup>

Applicant will now proceed with further arguments against the rejection, while assuming for the sake of argument that Maltzman were qualified for use as prior art.

It seems to applicant that the Examiner remains in the mode of assembling bits and pieces of the prior art to achieve a hindsight reconstruction of the claimed invention, and then casts about for reasons for the asserted combination of references.

The Examiner’s newly stated rationale for combining Maltzman with Moshal is “to offer a system for a plurality of exchanges”<sup>2</sup>. However, this goal, as stated in Moshal, would not require sales of shares to be incorporated in Maltzman. Further, and in any event, with Moshal

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<sup>1</sup> Much the same may be said about the Sloan reference upon which the Examiner now relies.

<sup>2</sup> Page 7, first paragraph of the present Office Action.

being concerned with exchanges and not IPOs, there is nothing in Moshal that provides any reason for applying any teachings in Maltzman to allocation of shares in IPOs, as recited in claim 1.

For the foregoing reasons, it is respectfully submitted that the pending prior art rejection of claim 1 is not well-founded, and should be reconsidered and withdrawn.

Claims 3-9 are submitted as patentable on the same basis as claim 1.

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Applicant notes that the status of claims 10-12 in respect of allowability over prior art is not clearly indicated in the pending Final Office Action.

## CONCLUSION

Accordingly, Applicant respectfully requests allowance of the pending claims. If any issues remain, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is kindly invited to contact the undersigned via telephone at (203) 972-3460.

Respectfully submitted,

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Date

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